UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,850	06/13/2006	Hans-Detlef Luginsland	274669US0PCT	5763

22850 7590 01/07/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
PARVINI, PEGAH	

ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
01/07/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/542,850	LUGINSLAND ET AL.	
	Examiner	Art Unit	
	Pegah Parvini	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,18,19 and 23-31* is/are pending in the application.

4a) Of the above claim(s) *9-18 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,18,19 and 23-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20071019*.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8, 18-19, 23, and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 16-18, and 21 of copending Application No. 10/542,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are overlapping ranges between the physical and chemical properties claimed for precipitated silica in both applications; furthermore, both applications claim same

structure for organosilanes used to modify silica. Moreover, they both claim the same intended use for the claimed precipitated silica such as in vulcanizable rubber.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The rejection of claims 1-18, 18-19 and 23, under Title 35 U.S.C. 103(a) over Esch et al. in view of Boyer et al. as generally set forth in the previous Office Action is proper and stands.

4. The rejection of claims 1-8, 18-19, and 23-29, under Title 35 U.S.C. 103(a) over Esch et al. in view of Luginsland as generally set forth in the previous Office Action is proper and stands.

Response to Amendment

5. Applicants' amendments to claims 1, 8, and 28-30, filed November 29, 2007, pages 2, and 10-11 are acknowledged. However, the amendments do not place the application in condition for allowance.

6. Applicants' amendment to the claims by canceling claims 21 and 22, filed November 29, 2007, page 7, is acknowledged.

Response to Arguments

7. Applicant's arguments filed November 29, 2007 have been fully considered but they are not persuasive.

8. Applicants have argued that the combination of Esch et al. in view of Boyer et al. or in view of Luginsland et al. do not disclose the combination of features as claimed in the instant application; in particular, Applicants have argued that the high ratio of Sears value V_2 to BET is not found in the prior art and that the analysis of the Examiner is incorrect.

The Examiner, respectfully, disagrees and submits that Applicants have taken into consideration the examples on Esch et al. However, the references disclose a broader limitation for the BET and Sears values (columns 1 and 2). Even though the Esch et al. do not disclose a specific embodiment of their invention which would anticipate the claimed invention, the broader disclosure of Esch et al. is seen to read upon the limitations of instant application, specially with regards to a ratio of Sears value to BET, because Esch et al. disclose BET surface area of 35 to 350 and Sears values of 6 to 20. Also, it is, respectfully, noted that although the Applicants asserts that all examples of Esch et al. prove that the analysis of the Examiner is incorrect, values for BET and Sears were only found in Example 3 (column 7) which made it possible to conduct said calculations. Furthermore, the rejections of the claims of the instant application are done under Title 35 U.S.C. 103(a) and not under Title 35 U.S.C. 102(b)

because there were found overlapping of ranges of the limitations recited in said claims with the disclosure of the references.

Based on the disclosure of Esch et al. (columns 1 and 2), the calculated ratio of Sears value to BET includes a range which has overlapping ranges with the instantly claimed ranges of Sears value to BET as recited in claim 1.

9. Applicants have argued that Esch et al. do not disclose the claimed moisture level and modification of one property can easily change a range of other properties; thus, the prior art do not meet the limitation of the moisture level.

The Examiner, respectfully, disagrees and submits that, as pointed out in the previous Office Action and disclosed clearly by Boyer et al., depending on a particular purpose of use of the silica, parameters and/or conditions during the procedure of producing precipitated silica may be changed accordingly to obtain differences in properties which provides a precipitated silica in a specific application. The motivation has been clearly disclosed by Boyer et al. and mentioned in the previous Office Action.

10. Applicants have traversed the provisional double patenting rejection.

The Examiner, respectfully, submits that the provisional double patenting rejection, as repeated above, is proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegah Parvini whose telephone number is 571-272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP